

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|-------------------------------------|---|------------------------|
| In re application of: Manfred Geier |) | |
| Application No.: 10/576,091 |) | Confirmation No.: 5596 |
| |) | |
| Group Art Unit: 3723 |) | |
| |) | |
| Examiner: Robert C. Watson |) | |
| |) | |
| Filed: April 11, 2006 |) | |
| |) | |
| Title: CLAMPING AND/OR |) | |
| SPREADING TOOL |) | |
| |) | |

Mail Stop: Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 C.F.R. §§1.144 and 1.181

The applicants hereby petition and ask for review of the Examiner's restriction requirement as set forth in the Office Action dated December 3, 2008 and made final in the Office Action dated February 25, 2009.

It is requested that the restriction requirement to claims 34 through 44 and 46 through 50 be withdrawn and that all of the pending claims be examined on the merits.

This petition is properly and timely filed under 37 C.F.R. §1.144 which provides that the there must be a final requirement for restriction and the petition must be filed not later than appeal. Section 1.144 also requires that reconsideration of the requirement must have been requested. The restriction requirement was made final in the Office action dated February 25, 2009. The restriction requirement was traversed and reconsideration of the requirement was requested in applicants' response filed December 18, 2008. No

appeal has been filed in this application. Accordingly it is submitted that this petition is properly and timely filed under 37 C.F.R. §§1.144 and 1.181.

Statement of Facts

The invention relates to a clamping or spreading tool, commonly referred to as a bar clamp. The original application disclosed a number of different embodiments for such a tool and was filed with 33 claims.

The Patent Office issued an election of species on September 22, 2008 identifying three patentably distinct species:

Species (1) Figures 1 – 5;

Species (2) Figures 6 – 8; and

Species (3) Figure 9.

In response to the election of species, the applicants elected Species (3), Figure 9, without traverse. The applicant also canceled original claims 1 through 33 and added 16 new claims (claims 34 through 50) all readable on Species (3), Figures 9a – 9d. Claims 34 through 50, as currently amended, are attached hereto in Exhibit A.

The elected embodiment shown in Figures 9a – 9d comprises a clamping and spreading tool comprising a support 305 supporting a first jaw 311. A rod 303 is supported in the support 305 for movement relative to the support. A movable jaw 313 is supported on the rod 303. A spring 365 moves the rod 303 to move the movable jaw 313 toward the first jaw 311. The spring 365 has a first end and a second end where the first end is supported in the support 305 and the second end is connected to the rod 303 external of the support 305. A handle is provided on the support and a drive arm 371 is movable relative to the handle for moving the movable jaw 313 toward the first jaw 311. The spring 365 has a first portion wound and rotatably supported in the support and a second unwound portion extending along the rod 303. The unwound portion is at least partly positioned in a seat or a groove 355 of the rod 303. A release lever occupies a first position in which it engages the rod 303 for holding the rod in a stationary position and a

second position in which it is disengaged from the rod 303 to allow the spring 365 to move the rod.

The Patent Office issued a restriction requirement on December 3, 2008. The restriction requirement set forth the following seven inventions:

- I. Claim 37, drawn to a clamping/spreading tool having a point of spring application force on a rod that is detachable.
- II. Claim 38, drawn to a clamping/spreading tool having a point of spring application force on a rod that is shiftable.
- III. Claim 39, drawn to a clamping/spreading tool having a spring that is wound in the support.
- IV. Claims 40, 42, 43, and 49, drawn to a clamping/spreading tool having a spring that is an unwound band seated in a groove of the rod.
- V. Claims 44 and 50, drawn to a clamping/spreading tool having a first end of a spring that is rotatably supported on the support.
- VI. Claim 45, drawn to a clamping/spreading tool having a handle on the support.
- VII. Claims 47 and 48, drawn to a clamping/spreading tool having a release lever.

The restriction requirement further found that claims 34, 41 and 46 are linking claims and that claims 35 and 36 would be examined with any group that is elected.

In a response filed December 18, 2008, the applicants provisionally elected Invention IV, comprised of claims 40, 42, 43 and 49, with traverse. Independent claims 34, 41 and 46 were amended to include the limitations of previously presented claim 45 (claim 45 was canceled). Under the terms of the restriction requirement, and based on applicants' election of Invention IV, at least claims 34, 35, 36, 40, 41, 42, 43, 46 and 49 should have been examined.

In the last received Office Action, the Examiner made the requirement final. Further, the Examiner withdrew from consideration claims 35 through 39, 44, 47, 48 and 50. Claims 34, 40, 41, 42, 43, 46 and 49 were examined on the merits.

Argument

I. The Final Requirement is Not Consistent with the Terms of the Restriction Requirement as Set Forth by the Examiner.

The Final requirement and the action on the merits is not consistent with the terms of the restriction requirement as originally set forth by the Examiner. The Examiner in the restriction requirement dated December 3, 2008 clearly indicated that claims 35 and 36 would be examined with any group that is elected. In the outstanding Office Action claims 35 and 36 were withdrawn from consideration as being drawn to a non-elected invention. It is submitted that the Final requirement is not consistent with the restriction requirement as originally set forth and that the withdrawal of claims 35 and 36 from consideration should be reversed. The applicants request that the final restriction requirement be withdrawn and that claims 35 and 36 be treated on the merits.

II. The Restriction Requirement is Improper as to All of the Pending Claims

M.P.E.P. § 803 states that two criteria for proper restriction of claims must be met: 1) The inventions must be independent or distinct as claimed AND 2) there must be a serious burden on the examiner if restriction is required. M.P.E.P. § 803 further states that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” According to M.P.E.P. § 806.03, “Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required.” This is because the claims are different definitions of the same disclosed subject matter, varying in breadth or scope of definition. Included in the first step may be a finding of the presence of subcombinations disclosed as usable together, but such subcombinations must be shown to not overlap. M.P.E.P. § 806.05(d). Second, the examiner must explain why there would be serious burden on the examiner if restriction is not required.

While M.P.E.P. § 806.05(d) requires that distinct claims not be overlapping, the converse is not required. That is to say, there is no requirement that overlapping claims must be viewed to be the same as each other. It is perfectly logical to have at least two things that overlap in some ways but are different in other ways. In the present case elected claim 40 (dependent on claim 34) sets forth a tool where the spring comprises “an unwound band section of said spring that is at least partly positioned in a seat or a groove of said push or pull rod”. Withdrawn claim 39 (also dependent on claim 34) sets forth a tool wherein “said spring is wound in said support”. Withdrawn claim 44 sets forth a tool according to claim 41 wherein the “first end of the spring is rotatably supported on the support”. Further, withdrawn claim 50 sets forth that the first end of the spring “is rotatably supported on the support”. Clearly the withdrawn claims include subject matter that overlaps with one another and with elected claim 40. As a result, examination of these claims presents no serious burden on the Examiner. As demonstrated by the example embodiment discussed above, in some aspects the scope of all of the claims overlap. However, that overlap does not preclude the fact that each claim also encompasses subject matter within its scope that is different than the subject matter encompassed by the other claims. Thus, it is reasonable to use multiple related claims to describe an invention, and there are no grounds for restricting such related overlapping claims into independent groups of inventions. It is requested that the restriction requirement as to claims 39, 44 and 50 be withdrawn and these claims be examined on the merits.

Claims 37 and 38 were restricted from one another and from the other identified inventions. Claim 37 states that the point of application of force of the spring is detachable from the rod while claim 38 states that the point of application of force of the spring can be shifted along the rod. Claims 37 and 38 clearly define overlapping subject. Both claims relate to the point at which that force of the spring is applied to the rod. Claim 37 states that this point is detachable while claim 38 states that this point is shiftable. In operation, one way to “shift” this point is to “detach” the spring such that the spring can be relocated or “shifted” to another point. Clearly the subject matter in these claims overlaps such that there would be virtually no additional burden on the

Examiner in examining these claims together. Further, the elected claims include the limitation that “said second end [of the spring] being connected external of said support for moving said rod” (claims 41 and 46). Claims 35 and 36 (indicated as being examined with any group that is elected as discussed above) state that the spring is connected to the push or pull rod. Thus, the elected claims include the limitation that the spring is connected to the rod or is connected external of the support to move the rod. It is submitted that withdrawn claims 37 and 38 describe subject matter that overlaps, but further defines, the subject matter of elected claims 35, 36, 41 and 46.

In searching the requirement of a spring that has an end connected to the rod the search for a detachable or shiftable connection of the same structure would pose no serious burden on the Examiner. It is recognized that the additional claim limitations of dependent claims 37 and 38 poses some burden on the Examiner; however, it is the burden posed by any dependent claim that simply modifies a previous claim term. It is submitted that the burden imposed on the Examiner by claims 37 and 38 is not the serious burden contemplated by M.P.E.P. § 803.

Claims 47 and 48 were also restricted from the other identified inventions. The claims set forth a release lever occupying a first position in which it engages the rod for holding the rod in a stationary position (claim 47) a second position in which it is disengaged from the rod to allow the spring to move the rod (claim 48). Claims 47 and 48 clearly define subject matter that overlaps with the subject matter of the examined claims. The claims refer to a release lever that allows the bar to move relative to the support to allow the jaws to be moved towards and away from one another. Disengagement of the release lever allows the spring to move the movable jaw as described in the independent claims. Release levers are common features of bar clamps. In fact, the reference relied on by the Examiner (Hall U.S. Pat. No. 6,568,667) discloses release mechanisms at reference numerals 110, 120 and 130. In the present invention the release lever overlaps with the subject matter of the claims because the disengagement of the release lever from the rod allows the spring to operate to move the rod. Clearly the subject matter in these withdrawn claims overlap with the subject matter of the examined claims such that there

would be virtually no additional burden on the Examiner in examining these claims together. It is submitted that claims 47 and 48 describe subject matter that overlaps, but further defines, the subject matter of the examined claims.

In searching for a clamp that uses a spring, as set forth in the elected claims, and to also search for a release lever as is commonly used on such clamps would pose no serious burden on the Examiner. It is recognized that the additional claim limitations of dependent claims 37 and 38 pose some burden on the Examiner; however, it is the burden posed by any dependent claim that simply modifies an independent claim. It is submitted that the burden imposed on the Examiner by claims 37 and 38 is not the serious burden contemplated by M.P.E.P. § 803.

Conclusion

It is submitted that as to claims 35 and 36 the Final requirement is not consistent with the restriction requirement as originally set forth and that the withdrawal of claims 35 and 36 from consideration should be reversed. The applicants request that the final restriction requirement be withdrawn and that claims 35 and 36 be treated on the merits.

It is further submitted that there is no serious burden on the Examiner in the present case. Applicant reiterates that the instant invention is a straightforward mechanical device in a predictable art area. Applicant has provided claims for the device that describe different aspects of the invention, as required under 35 U.S.C. § 112. The claims have overlapping subject matter as explained above. The Examiner has failed to provide anything other than conclusory reasons for the restriction, especially with regard to exactly what features of the claims will make the search burden serious if the restriction is not upheld. It is submitted that the search for the different inventions will be very similar, if not identical. The applicants request that the final restriction requirement be withdrawn as to all of the claims and that claims 35 through 39, 44, 47, 48 and 50 be treated on the merits.

Respectfully submitted,

Manfred Geirer

(Applicant)

Date: May 26, 2009

By: 

Dennis J. Williamson
Registration No. 32,338
Attorney for Applicant
Moore & Van Allen, PLLC
P.O. Box 13706
Research Triangle Park, N.C. 27709
Phone: 919-286-8000
Facsimile: 919-286-8199

EXHIBIT A

34. (Currently amended) A clamping and/or spreading tool comprising a drive for displacement of a push or pull rod to which a movable jaw is fixed with respect to a support carrying a stationary jaw in a longitudinal direction of the push and pull rod, said drive comprising a torsion spring connected to the push or pull rod for displacement of the push or pull rod to move said movable jaw toward said stationary jaw, wherein the torsion spring comprises an unwound band section that is at least partly positioned in a seat or a groove of said push or pull rod between the support and the movable jaw and a wound band section positioned in said support and further including a handle on said support and a drive arm movable relative to said handle for moving the movable jaw toward said first jaw, said handle and said drive arm being operable by one hand.
35. (Withdrawn) The clamping and/or spreading tool according to claim 34 wherein said spring is a torsion spring fixed on said support and to said push or pull rod.
36. (Withdrawn) The clamping and/or spreading tool according to claim 34 wherein said spring is a torsion spring fixed on said support and to said movable jaw.
37. (Withdrawn) The clamping and/or spreading tool according to claim 34 wherein a point of application of force of said spring on said push or pull rod is detachable.
38. (Withdrawn) The clamping and/or spreading tool according to claim 34 wherein and the point of application of force can be shifted along said push or pull rod.
39. (Withdrawn) The clamping and/or spreading tool according to claim 34 wherein said spring is wound in said support.
40. (Canceled)

41. (Currently amended) A clamping and/or spreading tool comprising:
a support supporting a first jaw;
a rod supported in said support for relative movement relative to said support;
a movable jaw supported on said rod;
a spiral band spring for moving said rod to move said movable jaw toward said first jaw, said spring having a first end and a second end, said first end being wound and supported completely within said support and said second end being connected external of said support to said rod for moving said rod and further including a handle on said support and a drive arm movable relative to said handle for moving the movable jaw toward said first jaw, said handle and said drive arm being operable by one hand.
42. (Canceled)
43. (Currently amended) The clamping and/or spreading tool of claim 41 wherein said unwound portion is at least partly positioned in a seat or a groove of said rod.
44. (Withdrawn) The clamping and/or spreading tool of claim 41 wherein the first end of the spring is rotatably supported on the support.
45. Canceled
46. (Currently amended) A clamping and/or spreading tool comprising:
a support having a handle and supporting a first jaw;
a rod having a length supported by said support for relative movement relative to said support;
a movable jaw supported on said rod;
a handle on said support and a drive arm movable relative to said handle for moving the movable jaw toward said first jaw, said handle and said drive arm being operable by one hand;

a spiral band spring for moving said rod to move said movable jaw toward said first jaw, said spring having a wound portion and an unwound portion arranged such that said spring extends along the length of the rod between the support and the movable jaw, said wound portion being supported in said support and said unwound portion being connected to said rod external of said support for moving said rod.

47. (Withdrawn) The clamping and/or spreading tool of claim 46 further including a release lever occupying a first position in which it engages the rod for holding the rod in a stationary position.
48. (Withdrawn) The clamping and/or spreading tool of claim 47 wherein said release lever occupies a second position in which it is disengaged from the rod to allow the spring to move the rod.
49. (Currently amended) The clamping and/or spreading tool of claim 46 wherein said unwound portion is at least partly positioned in a seat or a groove of said rod.
50. (Withdrawn) The clamping and/or spreading tool of claim 46 wherein the first end of the spring is rotatably supported on the support.